



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,788	10/30/2003	Michael J. Bullinger	10226.10USII	1146
23552	7590	10/06/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			A, PHI DIEU TRAN	
			ART UNIT	PAPER NUMBER
			3637	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)	
10/697,788	BULLINGER, MICHAEL J.	
Examiner	Art Unit	
Phi D. A	3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 03 October 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-27 is/are pending in the application.

4a) Of the above claim(s) 1-7, 26 and 27 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 8-25 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/3/04, 10/30/03.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 20-25 have been renumbered claims 22-27. ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to method of forming a gutter and cover system, classified in class 29, subclass 897.3.
- II. Claims 8-25, drawn to a gutter and cover system, classified in class 52, subclass 11.
- III. Claim 26, drawn to an apparatus, classified in class 72, subclass 380.
- IV. Claim 27, drawn to a process of making a gutter and cover, classified in class 72, subclass 334.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the

product as claimed can be made by another and materially process; for example, the gutter and cover being extruded separately.

3. Inventions II and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case, the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product; for example, the apparatus can be used to form corrugated panels.

4. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process; for example, the gutter and cover can be rolled formed, manually pressed together, and then crimp together.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Gregory Sebald on 9/28/05 a provisional election was made with traverse to prosecute the invention of II, claims 8-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-7, 26-27 are withdrawn

from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 20-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claimed limitations of “securing the internal support . . . extends through a hole in the debris separation portion of the cover and into a hole in the debris separation support segment” is not enabled or supported by the specification. The specification and the drawings only disclose the hardware extending through the gutter and the support segment, not the support segment and the cover.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 8, 10-11, 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Knudson (5845435).

Per claims 8, 10-11, 13-16, Knudson (figures 10-11) shows a gutter and cover system comprising a gutter (96) formed from a first coil of material having a front face(97), a bottom and a rear portion (98) extending upward to a top segment, a cover system (99 and part 131) formed from a second coil of material, the cover extends over the gutter and has a debris separation portion (1060 extending above the front face of the gutter, a flange portion (99a) extending upward adjacent the top segment of the gutter, interlocking means (the top of part 99a, and the part to the left of it, and part 98a) for coupling the gutter and cover together to form a single unit, the interlocking means comprising crimping the top segment of the gutter and the flange portion of the cover together to interlock the top segment of the gutter with the flange portion of the cover, the gutter is made of a first material and the cover is made of a second material, the first material being aluminum, the gutter and cover are attached without a connector member (the claims thus far have not positively claimed a connector member), mounting means for securing the system to the edge of the roof, the mounting means further comprising mounting hardware(75) for securing the system to the edge of the roof, the mounting hardware extends through a hole in the gutter and cover system.

Per claims 17-19, Knudson (figures 10-11) shows a gutter and cover system comprising a gutter (96) formed from a first coil of material having a front face(97), a bottom and a rear portion (98) extending upward to a top segment, a cover system (99) formed from a second coil of material, the cover extends over the gutter and has a debris separation portion (1060 extending above the front face of the gutter, a flange portion (99a) extending upward adjacent the top segment of the gutter, interlocking means (the top of part 99a, and the part to the left of it, and part 98a) for coupling the gutter and cover together to form a single unit, an internal support

member (131) for reinforcing the gutter and the cover, the internal support member further comprising a debris separation support segment (108) juxtaposed to an underside of the debris separation portion of the cover, a rear portion (1410 extending downward to a front face segment, fixation means (75) for securing the internal support member with respect to the gutter and cover system, the internal support is repeatedly positioned at determined distances along the gutter and cover system, the front face defines a continuously curved profile.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 9, 22, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson (5845435) in view of Manoogian Jr (5072551).

Knudson shows all the claimed limitations except for the cover comprising a kinetic energy dispersion section intermediate the rear portion of the gutter and the debris separation portion of the cover.

Manoogian Jr. discloses a kinetic energy dispersion section (at 20) intermediate the rear portion of the gutter and the debris separation portion of the cover to enable the slowing of rain water so that rain water would properly drain into the gutter.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Knudson's structure to show the cover comprising a kinetic energy dispersion section intermediate the rear portion of the gutter and the debris separation portion of

the cover because it would allow for the slowing of rain water so that rain water would properly drain into the gutter as taught by Manoogian Jr.

13. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson (5845435) in view of Manoogian Jr (5072551).

Knudson shows all the claimed limitations except for the second material comprising copper.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Knudson's structure to show the second material comprising copper because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, *In re Leshin*, 125 USPQ 416, furthermore, aluminum and copper are well known material outdoor use it is rust resistant, and are commonly used on areas exposed to the elements.

14. Claims 23, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson (5845435) in view of Manoogian Jr (5072551).

Knudson as modified shows all the claimed limitations except for the gutter front face defining a K-style or square profile.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Knudson's modified structure to show the gutter front face defining a K-style or square profile because it would have been an obvious matter of engineering design choice to have the face being K-style or square profile since applicant has not disclosed that the different profiles solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the front face being continuously curved.

15. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson (5845435) in view of Manoogian Jr (5072551)

Knudson as modified shows all the claimed limitations except for the mounting hardware extends through a hole in the debris separation portion of the cover and into a hole in the debris separation support segment.

Manoogian Jr. further shows a mounting hardware (28) extends through a hole in the debris separation portion of the cover (the part above 18) to enable the secured mounting of the cover and gutter system.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Knudson's modified structure to show the mounting hardware extends through a hole in the debris separation portion of the cover and into a hole in the debris separation support segment because it would enable the secured fastening of the gutter and cover system to the roof structure as taught by Manoogian Jr.

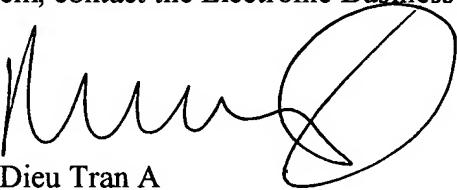
### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different gutter and cover systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Tuesday, Thursday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phi Dieu Tran A

9/29/05